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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/777,592
Filing Date: February 05, 2001
Appellant(s): RYAN, FREDERICK W.

Brian A. Lemm
(Reg. No. 43,748)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 21, 2008, appealing from the Office action mailed January 25, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal to the Board of Patent Appeals and Interferences for application no. 09/748,889.

(3) Status of Claims

In Applicant's appeal brief, filed April 21, 2008, the status of the cancelled claims was missing from the Status of Claims section. Examiner responded with a Notification of Non-Compliant Appeal Brief, dated April 24, 2008, which stated the defect. Applicant responded with a Response to Notification of Non-Compliant Appeal Brief, filed April 29, 2008, which supplied a replacement for the Status of Claims section that corrected the defect. However, Applicant did not provide an entire amended appeal brief, just an amended Status of Claims section. MPEP 1205.03 is unclear on whether an entire amended appeal brief is required in this situation. That section of the MPEP lists some situations where replacing only one section of the defective appeal brief is acceptable, but does not list this particular situation and does not state whether or not the listed situations are the only situations where an entire amended appeal brief is not required. Due to the fairly minor nature of the non-compliancy, Examiner has chosen to accept Applicant's correction of the defective appeal brief, but with this explanation.

The replacement statement of the status of claims contained in the Response to Notification of Non-Compliant Appeal Brief, filed April 29, 2008, is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,280,531	HUNTER	1-1994
5,917,925	MOORE	6-1999
4,933,849	CONNELL ET AL.	6-1990
5,819,239	BERSON ET AL.	10-1998
5,953,710	FLEMING	9-1999
5,822,739	KARA	10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9-1. Claims 2, 4, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter, U.S. Patent No. 5,280,531, in view of Moore, U.S. Patent No. 5,917,925, in further view of Connell et al., U.S. Patent No. 4,933,849.

As per **Claim 2**, Hunter discloses:

- a mail piece verification system for processing mail pieces, the mail pieces having associated therewith respective mail piece data (column 1, lines 51-68; column 2, lines 3-24; system helps verify if mail pieces have valid indicia by detecting postal meter fraud; processes a stream of mail pieces; postage amount and meter identification number are mail piece data);

- the data center including a plurality of account files corresponding to a plurality of postage metering systems (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; data center would be wherever the data processing system is located; account files include expenditure file and refill file; data center can hold information corresponding to a plurality of meters);

- the data center being adapted to store reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems, respectively (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; refill file contains such information; data center can hold information corresponding to a plurality of meters; reset data is stored in each of the account files that are representative of reset activity associated with the meters; reset data is stored in files that correspond to their respective meters);

- store empirical data in each of the plurality of account files representative of mailing activity associated with the plurality of postage metering systems, respectively (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; expenditure file contains such empirical data; data center can hold information corresponding to a plurality of meters; empirical data is stored in each of the account files that are representative of mailing activity associated with the meters; empirical data is stored in files that correspond to their respective meters);

- conduct a forensic accounting analysis of the empirical data and the reset data associated with a selected postage metering system using a previously defined time period over which to conduct the forensic accounting analysis (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; column 4, lines 53-68; column 5, lines 1-44; column 7, lines 1-7; forensic accounting analysis here is the comparison of postage purchased with postage used for the purpose of detecting potential mail fraud; empirical data here is in the expenditure file; reset data here is in the refill file; threshold may vary as a function of time; therefore, time period would need to be previously defined in order to determine threshold; analysis may be performed on a predetermined schedule);

- wherein the data center initiates responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

Hunter fails to disclose a data center in operative communication with a plurality of mail processing centers. Moore discloses a data center in operative communication with a plurality of

mail processing centers (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17; data center here would be the location of the control computer; mail processing centers here would be the postal inspection stations). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter such that it includes a data center in operative communication with a plurality of mail processing centers, as disclosed by Moore. Motivation is provided by Moore in that having a data center in operative communication with a plurality of mail processing centers allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17).

Hunter fails to disclose receiving respective mail piece data corresponding to the mail pieces from the plurality of mail processing centers. Moore discloses receiving respective mail piece data corresponding to the mail pieces from the plurality of mail processing centers (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17; mail piece data here are scanned indicia; mail processing centers here would be the postal inspection stations). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that it receives respective mail piece data corresponding to the mail pieces from the plurality of mail processing centers, as disclosed by Moore. Motivation is provided by Moore in that receiving such mail piece data allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17).

Hunter and Moore fail to disclose wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system. Connell et al. discloses wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system (column 1, lines 30-52; column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system, as disclosed by Connell et al. Motivation is provided by Connell et al. in that requiring new graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

Hunter and Moore fail to disclose wherein graphic change information is downloaded to the selected postage metering system. Connell et al. further discloses wherein graphic change information is downloaded to the selected postage metering system (column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that graphic change information is downloaded to the selected postage metering system, as disclosed by Connell et al. Motivation is provided by Connell et al. in that changing graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

As per **Claim 4**, Hunter further discloses wherein the responsive action includes conducting an inspection of the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

As per **Claim 9**, Hunter discloses:

- a method of operating a mail piece verification system for processing mail pieces, the mail pieces having associated therewith respective mail piece data (column 1, lines 51-68; column 2, lines 3-24; method helps verify if mail pieces have valid indicia by detecting postal meter fraud; processes a stream of mail pieces; postage amount and meter identification number are mail piece data);

- obtaining the respective mail piece data from the mail pieces (column 2, lines 3-24; mail piece data here would include meter identification number);

- maintaining a plurality of account files corresponding to the plurality of postage metering systems (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; account files include expenditure file and refill file; reference's invention can hold information corresponding to a plurality of meters);

- storing reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems, respectively (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; refill file contains such information; reference's invention can hold information corresponding to a plurality of meters; reset data is stored in each of the account files that are representative of reset

activity associated with the meters; reset data is stored in files that correspond to their respective meters);

- using the respective mail piece data, storing empirical data in each of the plurality of account files representative of mailing activity associated with the plurality of postage metering systems, respectively (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; mail piece data here would include meter identification number; mail piece data is used in that meter identification number identifies to what meter the mail piece's data pertains; expenditure file contains such empirical data; reference's invention can hold information corresponding to a plurality of meters; empirical data is stored in each of the account files that are representative of mailing activity associated with the meters; empirical data is stored in files that correspond to their respective meters);

- conducting a forensic accounting analysis of the empirical data and the reset data associated with a selected postage metering system using a previously defined time period over which to conduct the forensic accounting analysis (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; column 4, lines 53-68; column 5, lines 1-44; column 7, lines 1-7; forensic accounting analysis here is the comparison of postage purchased with postage used for the purpose of detecting potential mail fraud; empirical data here is in the expenditure file; reset data here is in the refill file; threshold may vary as a function of time; therefore, time period would need to be previously defined in order to determine threshold; analysis may be performed on a predetermined schedule);

- initiating responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

Hunter fails to disclose receiving mail pieces at a plurality of mail processing centers that have been prepared by a plurality of postage metering systems. Moore discloses receiving mail pieces at a plurality of mail processing centers that have been prepared by a plurality of postage metering systems (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17; mail processing centers here would be the postal inspection stations). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter such that it receives mail pieces at a plurality of mail processing centers that have been prepared by a plurality of postage metering systems, as disclosed by Moore. Motivation is provided by Moore in that receiving such mail pieces at a plurality of mail processing centers allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (column 9, line 59, through column 11, line 19; column 24, line 21, through column 25, line 17).

Hunter and Moore fail to disclose wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system. Connell et al. discloses wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system (column 1, lines 30-52; column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that the responsive

action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system, as disclosed by Connell et al. Motivation is provided by Connell et al. in that requiring new graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

Hunter and Moore fail to disclose wherein graphic change information is downloaded to the selected postage metering system. Connell et al. further discloses wherein graphic change information is downloaded to the selected postage metering system (column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that graphic change information is downloaded to the selected postage metering system, as disclosed by Connell et al. Motivation is provided by Connell et al. in that changing graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

As per **Claim 11**, Hunter further discloses wherein the responsive action includes conducting an inspection of the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

9-2. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Moore in further view of Connell et al. in further view of Berson et al. U.S. Patent No. 5,819,239.

As per **Claim 7**, Hunter, Moore, and Connell et al. fail to disclose wherein the responsive action includes issuing instructions to increase a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system. Berson et al. discloses wherein the responsive action includes issuing instructions to increase a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system (column 8, line 60, through column 9, line 5; column 9, line 29, through column 11, line 59; an audit here would involve an increased sample rate, a higher level of inspection). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified in the rejection for claim 2 such that the responsive action includes issuing instructions to increase a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system, as disclosed by Berson et al. Motivation is provided by Berson et al. in that performing an audit in response to initial sampling data allows for review of a mailer's accounts when there is some indication of a need for such an audit (column 8, line 60, through column 9, line 5; column 9, line 29, through column 11, line 59).

As per **Claim 14**, Hunter, Moore, and Connell et al. fail to disclose increasing a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system. Berson et al. discloses increasing a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system (column 8, line 60, through column 9, line 5; column 9, line 29, through column 11, line 59; an audit here would involve an increased sample rate, a higher level of inspection). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified in the

rejection for claim 9 such that it increases a sample rate for mail pieces including mail piece data corresponding to the selected postage metering system, as disclosed by Berson et al. Motivation is provided by Berson et al. in that performing an audit in response to initial sampling data allows for review of a mailer's accounts when there is some indication of a need for such an audit (column 8, line 60, through column 9, line 5; column 9, line 29, through column 11, line 59).

9-3. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Connell et al.

As per **Claim 16**, Hunter discloses:

- a method of operating a data center for processing data associated with mail pieces and a plurality of postage metering systems for preparing mail pieces (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; data center would be wherever the data processing system is located; processes data associated with mail pieces, such as meter identification number; reference's invention can process information corresponding to a plurality of meters);

- obtaining reset data representative of reset activity associated with the plurality of postage metering systems (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; reset data here is in the refill file; reference's invention can process information corresponding to a plurality of meters);

- obtaining empirical data representative of mailing activity associated with the plurality of postage metering systems (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49,

through column 4, line 17; column 4, lines 26-42; empirical data here is in the expenditure file; reference's invention can process information corresponding to a plurality of meters);

- conducting a forensic accounting analysis of the empirical data and the reset data associated with a selected postage metering system using a previously defined time period over which to conduct the forensic accounting analysis (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; column 4, lines 53-68; column 5, lines 1-44; column 7, lines 1-7; forensic accounting analysis here is the comparison of postage purchased with postage used for the purpose of detecting potential mail fraud; empirical data here is in the expenditure file; reset data here is in the refill file; threshold may vary as a function of time; therefore, time period would need to be previously defined in order to determine threshold; analysis may be performed on a predetermined schedule);

- initiating responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

Hunter fails to disclose wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system. Connell et al. discloses wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system (column 1, lines 30-52; column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter such that the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system, as

disclosed by Connell et al. Motivation is provided by Connell et al. in that requiring new graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

Hunter fails to disclose wherein graphic change information is downloaded to the selected postage metering system. Connell et al. further discloses wherein graphic change information is downloaded to the selected postage metering system (column 5, line 21, through column 6, line 31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified above in this rejection such that graphic change information is downloaded to the selected postage metering system, as disclosed by Connell et al. Motivation is provided by Connell et al. in that changing graphic data helps differentiate authorized generators of indicia from unauthorized generators of indicia (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

As per **Claim 18**, Hunter further discloses wherein the responsive action includes conducting an inspection of the selected postage metering system (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

9-4. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Moore in further view of Connell et al. in further view of Fleming, U.S. Patent No. 5,953,710.

As per **Claim 22**, Hunter further discloses the selected postage metering system having a serial number (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4,

line 17; column 4, lines 26-42). Hunter, Moore, and Connell et al. fail to disclose wherein the responsive action includes issuing a new identification number to replace an existing identification number. Fleming discloses wherein the responsive action includes issuing a new identification number to replace an existing identification number (column 5, line 63, through column 6, line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified in the invention for claim 2 such that the responsive action includes issuing a new identification number to replace an existing identification number, as disclosed by Fleming. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicant's invention that changing an identification number can help prevent fraud associated with the original identification number.

As per **Claim 23**, Hunter further discloses:

- the selected postage metering system having a serial number (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42);

- wherein the mail pieces contain serial numbers (column 2, lines 3-24).

Hunter, Moore, and Connell et al. fail to disclose issuing a new identification number to replace an existing identification number, allowing normal processing of items associated with the new identification number, and instructing the plurality of processing centers to withhold processing of items associated with the existing identification number. Fleming discloses issuing a new identification number to replace an existing identification number, allowing normal processing of items associated with the new identification number, and instructing the plurality

of processing centers to withhold processing of items associated with the existing identification number (column 5, line 63, through column 6, line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified in the rejection for claim 9 such that it issues a new identification number to replace an existing identification number, allows normal processing of items associated with the new identification number, and instructs the plurality of processing centers to withhold processing of items associated with the existing identification number, as disclosed by Fleming. Motivation is provided in the it was well-known to one of ordinary skill in the art at the time of applicant's invention that changing an identification number can help prevent fraud associated with the original identification number.

9-5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Connell et al. in further view of Fleming.

As per **Claim 24**, Hunter further discloses:

- the selected postage metering system having a serial number (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42);

- wherein the mail pieces contain serial numbers (column 2, lines 3-24).

Hunter and Connell et al. fail to disclose issuing a new identification number to replace an existing identification number, providing instructions to allow normal processing of items associated with the new identification number, and providing instructions to withhold processing of items associated with the existing identification number. Fleming discloses issuing a new identification number to replace an existing identification number, providing instructions to

allow normal processing of items associated with the new identification number, and providing instructions to withhold processing of items associated with the existing identification number (column 5, line 63, through column 6, line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Hunter as modified in the rejection for claim 16 such that it issues a new identification number to replace an existing identification number, provides instructions to allow normal processing of items associated with the new identification number, and provides instructions to withhold processing of items associated with the existing identification number, as disclosed by Fleming. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicant's invention that changing an identification number can help prevent fraud associated with the original identification number.

(10) Response to Argument

10-1. With respect to the prior art rejection of claim 2, Applicant begins by arguing that the combination of references fails to disclose the element/limitation of "download graphic data to the selected postage metering system to be included in the mail piece data of mail pieces subsequently prepared by the selected postage metering system if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system." Examiner disagrees and believes that a review of how this element/limitation is disclosed by the combination of references in the rejection would be of value here. Note first that Examiner did not use Connell et al. by itself to disclose this element/limitation. Rather, this element/limitation was disclosed via the combination of the following disclosures of Hunter and Connell et al.:

Hunter discloses:

A. "wherein the data center initiates responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system" (column 1, lines 51-68; column 2, lines 3-24; column 4, lines 26-42; column 5, lines 1-44).

Connell et al. discloses:

B. "wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system" (column 1, lines 30-52; column 5, line 21, through column 6, line 31).

C. "wherein graphic change information is downloaded to the selected postage metering system" (column 5, line 21, through column 6, line 31).

When the above disclosures are appropriately combined, the claimed element/limitation of "download graphic data to the selected postage metering system to be included in the mail piece data of mail pieces subsequently prepared by the selected postage metering system if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system" results. The following illustration sets out this process in a step-by-step fashion:

Step A:

Hunter discloses "wherein the data center initiates **responsive action** if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system."

Connell et al. discloses "wherein the **responsive action** includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system." In other words, Connell et al. discloses:

responsive action = including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system.

If the above equivalent language for **responsive action** is then substituted for the words **responsive action** in the above disclosure of Hunter, the following results:

"wherein the data center initiates including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system."

Step B:

The remaining difference between the immediately preceding disclosure combination and the claimed element/limitation being discussed is that of the graphic data actually being downloaded. However, Connell et al. separately discloses "wherein graphic change information is downloaded to the selected postage metering system." While "graphic change information" is a broader term than "graphic data," graphic data is in fact, in Connell et al., a type of graphic change information. Therefore, the modification of "wherein graphic change information is downloaded to the selected postage metering system" can be appropriately applied with treating graphic data as graphic change information. With this further modification to the immediately previous combined disclosure of Hunter and Connell et al., the following language results:

"wherein the data center initiates downloading and then including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system." While slightly differently phrased, this language includes the meaning of the claimed language at issue: "download graphic data to the selected postage metering system to be included in the mail piece data of mail pieces subsequently prepared by the selected postage metering system if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system."

Now, to further support the above counterargument, a further explanation of how each of the above three disclosures, A, B, and C, are provided in Hunter and Connell et al. will be provided.

Disclosure A:

Disclosure A, "wherein the data center initiates responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system," is disclosed in Hunter. Hunter first sets out, with respect to the prior art, that a comparison of postage purchased with postage used has the purpose of detecting counterfeit postage meter indicia, in column 1, lines 51-57, which state: "Presently the only other methods available to detect the use of counterfeit postage meter indicia is to inspect the mailstream, determine the cumulative total of postage preportedly printed by a given postage meter, and compare this to the recharge history of that meter; or to check the serial number printed in all meter indicia." Following this, Hunter sets out its object to accomplish such a function, in column 1, lines 64-68, which state: "Thus, it is an object of the subject invention to

provide a method and apparatus for efficient and low cost comparison of the total postage expended by a particular postage meter with the recharge history of that meter." This is nearly immediately expanded upon and supported in Hunter, column 2, lines 3-24, which state:

> "The above object is achieved and the disadvantages of the prior art are overcome in accordance with the subject invention by means of a method and system for the analysis of postal indicia printed by a postage meter. An optical character recognition system scans a mail piece from a stream of mail pieces to recognize a postage amount and a meter identification number imprinted on the mail piece. The subject invention also includes an input for input of data representing the recharge history for a postage meter which corresponds to the identification number, and a data processing system for controlling the system and implementing the method of the subject invention. The data processing system responds to the optical character recognition system and to the input to accumulate the postage amount in a first record associated with the identification number, store the recharge history in a second record associated with the identification number, compare the first and second records, and if the comparison of the first and second records shows a likelihood of unauthorized use of the postage meter, generate a discrepancy report."

Hunter, column 5, lines 3-5, further clarifies how a purpose of its invention is to detect postage meter fraud, by stating: "First, total expenditures which are greater than the total amount by which a meter has been recharged indicate the likelyhood of meter fraud." Finally, Hunter, column 5, lines 31-39, sets out the "responsive action" that is triggered by an inconsistent comparison of meter recharge history and postage submitted, by stating: "In this regard it should

be remembered that the purpose of the subject invention is neither to prove conclusively improper usage of a postage meter, but only to detect the likelihood of such improper usage so that further investigation may be made and to facilitate investigation by providing an automatic outsort capability; nor to detect every instance of improper usage." So, the "responsive action" triggered here is further investigation. By examining Applicant's specification, it can be seen that "empirical data" in claim 2 corresponds to the "expenditure file" (record of postage from a postal meter that is actually submitted on mail into the postal system) in Hunter and that "reset data" corresponds to the "refill file" (record of postage refill history for a postal meter) in Hunter. Therefore, Hunter does indeed disclose Disclosure A of "wherein the data center initiates responsive action if the forensic accounting analysis reveals that the empirical data is not consistent with the reset data for the selected postage metering system."

Disclosure B:

Disclosure B, "wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system," is disclosed in Connell et al. Connell et al. sets out that its invention's purpose (like Hunter) is to counter postal meter fraud in column 1, lines 30-52, which state:

> "In general, the United States Postal Service requires the inspection of postal meters twice a year. This inspection currently necessitates an on-site visit to the postage meter location by a representative of the postage meter manufacturer. Such visits represent a considerable expense for the manufacturer and, in fact, do not prevent a user from printing fraudulent postage indicia. The primary purpose of such visits is to inspect the postage meter to ascertain if the particular meter has been subjected to tampering.

> These inspections do not, however, prevent such fraudulent practices as the unauthorized printing of a postal indicia by another printer or the generation of a postal indicia by other means. Hence, although current security measures are quite effective, the implementation of new technologies to postal systems and services provides the opportunity for increasing the security thereof at relatively inexpensive investments.
>
> Consequently, a security system that can detect such fraudulent practices, as well as supplement required on-site inspections is clearly desired in industries that utilize indicia to represent monetary value."

Connell et al. further sets out the detailed operation of its invention in column 5, line 43, through column 6, line 31, which states:

> "Such a system usually communicates with a central funding source that may either fund it directly or fund it through a secondary, more remote, meter refunding system. In any event, an authorized party at one of these funding centers may implement the system 10 as a means of checking the validity of the various users. In general, a decision will be made to alter the particular indicia pattern placed upon the manifest, although the change could also be made upon individual mail pieces, and a date will be selected whereupon the change is to occur. Typically, user locations having such systems are frequently large mailers and frequently communicate with such central stations for receipt of new funds. Hence, once a decision is made to change the indicia pattern, all user locations that request fund changes will be provided with the address of the new authorized indicia pattern as well as the date that it becomes authorized. Naturally, and for uniformity only, the address location for this information in the computer 20 of all of

the means 12 is preferably predetermined during the installation of the device at the user location and, hence, the particular address would be common throughout this system 10. In any event, the particular address of the authorized indicia would thus be downloaded to each of the local means 12 along with the date that it is to become effective. In systems that do not communicate electronically with the means 16, the effective date can be set during a routine on-site inspection.

The operation of the system 10 can be effectively implemented via the flow diagram in FIG. 4. Therein, the means 12, for example, at some point in time subsequent to the processing of a batch of mail, is prepared to print a manifest having a postal indicia pattern thereon. The computer 20 would then make inquiry of the nonvolatile RAM 26 and compare the current date, provided by the clock/calendar 28, with the date located in memory block 68. If the date that the new postal indicia is to be authorized has not been reached, the computer 20 then reads the current graphics address block in memory block 70 and proceeds to print the current authorized indicia. However, upon determining that the date so supplied is equal to or later than the date whereupon the new indicia pattern has been authorized, the computer 20 then reads the graphics address block 66.

Preferably, at this point, the computer 20 also writes the address in address block 66 into the block 70 so that on subsequent printings the authorized indicia will always be printed. The computer 20 then accesses the particular authorized indicia graphic block and proceeds to print the indicia via the printer 32.

In this manner, only those authorized indicia printing means 12 will change the indicia pattern printed on the manifest and any authorized image printing means 12 that

presents a manifest to any post office that has the erroneous indicia printed thereon will be readily detectable and suspect by the USPS."

Note that in the above passage, it is stated that the graphic data changes may be made in the indicia that are printed on envelopes, as opposed to the manifest indicium. It should also be noted that the graphic data address downloaded to the postal meter is a memory address location in the postal meter itself; that is, the various choices for graphic data are already pre-stored in the postal meter and not downloaded. This is not a problem for the validity of the rejection, as will be seen. So, to sum up Connell et al. in a brief manner, counterfeit postage indicia are discovered by periodically downloading information to postal meters which indicate a new graphic data pre-stored within the meter to switch to with respect to placing on mail pieces, along with a date that the change is to become effective. Only currently valid postal meters are to receive such updates. Invalid postal meters will continue printing now-outdated graphic data on mail pieces after the specified date. Such now-outdated graphic data thus become graphic data indicative of postal fraud on mail pieces subsequently printed. The use of such graphic data to identify postal fraud, as can be seen in the above passages from Connell et al. is a **responsive action** to the overall problem of postage indicium fraud. While the responsive action in Connell et al. is not a responsive action in the same specific and immediate way that the responsive action in Hunter is, the responsive action in Connell et al. is still a responsive action.

Therefore, Connell et al. does indeed disclose Disclosure B of "wherein the responsive action includes including graphic data in the mail piece data of mail pieces subsequently prepared by the selected postage metering system."

Disclosure C:

Disclosure C, "wherein graphic change information is downloaded to the selected postage metering system," is disclosed in Connell et al. As was discussed in the above quoted passages from Connell et al., information is periodically downloaded to postal meters in Connell et al. to provide an address of graphic data within the postal meters to switch to with respect to printing the graphic data on envelopes, as well as a date the change becomes effective. Since this date and address specify when graphic data is to be changed, they are "graphic change information." Therefore, Connell et al. does indeed disclose Disclosure C of "wherein graphic change information is downloaded to the selected postage metering system."

One might question how downloading the graphic data can be arrived at from Hunter and Connell et al.'s disclosures when neither disclosure features the graphic data placed on mail pieces actually being downloaded. As was discussed above, while "graphic change information" is a broader term than "graphic data," graphic data is in fact, in Connell et al., a type of graphic change information, even if it is not the specific type of "graphic change information" being downloaded in Connell et al. Note that, under Connell et al., previously valid graphic data becomes an indicator of postal fraud when it becomes out-dated when it has been used on a mail piece after the date at which another graphic data was to be switched to. Therefore, even the out-dated "fraudulent" graphic data was originally an indicated graphic data that was to be switched to as valid at a certain date and thus falls under the term "graphic change information." Thus, the modification of "wherein graphic change information is downloaded to the selected postage metering system" can be appropriately applied with treating graphic data as graphic change information. When that modification is made to the previously combined elements/limitations of Hunter, Moore, and Connell et al., the graphic data from the previously combined

element/limitation of Connell et al. becomes downloaded graphic data. Again, it is important to note that two separate elements/limitations are being combined from Connell et al. IN SEQUENCE. So, the graphic data printed on mail pieces disclosed in the first element/limitation of Connell et al. is being modified using the second, separate element/limitation from Connell et al. such that it becomes downloaded as part of the overall combination of references for the rejection of claim 2. Therefore, the combination of references does indeed disclose the graphic data printed on the mail pieces being downloaded.

The above modification is actually an even stronger modification than if Examiner had simply taken official notice that obtaining information through downloading was well-known to one of ordinary skill in the art at the time of Applicant's invention. This is because (a) an actual reference was provided, and (b) the reference provided is very closely related to the overall field and problem of Hunter, that of postal meters and detecting postal meter fraud. It should also be noted that the modification to make graphic data downloadable was not a great leap in technology at the time of Applicant's invention. In this regard, see Kara, U.S. Patent No. 5,822,739, column 3, line 55, through column 4, line 20, and column 14, lines 30-54, which disclose an indicium image being remotely generated and downloaded to a local postage indicium printer.

Applicant also argues that Examiner used impermissible hindsight in making the rejection for claim 2. Examiner disagrees. As can be seen from the actual rejection, Examiner provided a valid motivation for every modification made in the rejection. Therefore, impermissible hindsight was not used.

Therefore, Applicant's arguments are not persuasive with respect to the rejection of claim 2.

10-2. All of Applicant's arguments regarding the other appealed claims follow from Applicant's arguments with respect to the patentability of claim 2, either via similarity to claim 2 or via dependency on claims argued as allowable. Since Applicant's arguments with respect to claim 2 are not persuasive, neither are Applicant's arguments with respect to these other claims.

10-3. Analogous art: Hunter is analogous art because it is in the field of Applicant's endeavor, that is, postal meters, and, more specifically, postal meter fraud. Moore is analogous art because it is in the field of Applicant's endeavor, that is, postal meters, and, more specifically, postal meter fraud. Connell et al. is analogous art because it is in the field of Applicant's endeavor, that is, postal meters, and, more specifically, postal meter fraud. Berson et al. is analogous art because it is in the field of Applicant's endeavor, that is, postal meters, and, more specifically, postal meter fraud. Fleming is analogous art because it is in the field of Applicant's endeavor, that is, business methods; the cited section is also directed toward fraud prevention, which is reasonably pertinent to the particular problem with which Applicant was concerned.

10-4. Regarding any arguments by Applicant regarding there being no teaching suggestion or motivation to combine the references used in the rejections under 35 U.S.C. 103, KSR forecloses any such argument that argues that a specific teaching is required for a finding of obviousness. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (U.S. 2007). The claims rejected under 35 U.S.C. 103 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nathan Erb/

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